Appln No.: 10/646,436
Amendment Dated: October 10, 2005
Reply to Office Action of July 22, 2005

REMARKS/ARGUMENTS

This is in response to the Office Action mailed July 22, 2005 for the above-captioned application. Reconsideration and further examination are respectfully requested.

Applicants note that Examiner's comments with regard to the priority claim and have amended the claims in view of these comments. In the claims as amended, the sequence length now refers to the length of the portion of the RNA molecule which is complementary to the sequence of the human clusterin. The specific lengths of this region as recited in the claims are 19-21 and 19. These lengths are supported in Table 1 of the application, where the sequence specific parts of the RNA sequences have lengths of from 19 to 21 bases. Applicants further note that it is well known in the art that additional non-sequence specific bases are commonly included in active RNAi species. Comparable amendments have been made in the withdrawn claim, so that the application is in form for allowance without further amendment should the generic claims be found allowable and the restriction requirement withdrawn.

Applicants submit that all claims are now entitled to the claim for priority. Accordingly, US Patent 6,383,808 is at not a reference under 35 USC § 102(e), although Applicants do not concede that it is prior art. For purposes of this response, however, Applicants will address the rejection on the merits.

The Examiner rejected claims 1-3 and 10-13 under 35 USC § 102(e) as anticipated by Monia et al (US Patent No. 6,383,808). The Examiner argues that Monia "teaches an oligonucleotide that can be RNA or a ribozyme and that is targeted to clusterin mRNA. Applicants respectfully submit that the disclosure of Monia as it relates to RNA molecules, however, cannot fairly be characterized as a teaching, and that Monia both fails to enable and to describe the invention as now claimed.

The entire disclosure of the Monia et al patent concerning RNA oligonucleotides as inhibitors is that which the Examiner has cited, namely the single passage in Col. 6. There is no disclosure of a single actual RNA sequence that has utility to "mediate degradation or block translation of mRNA that is the transcriptional product of a target gene" as required in the present claims. All of the sequences disclosed are DNA sequence. The mechanisms of action of DNA antisense and of RNAi, however, are understood in the art to be different. Thus, all Monia et al provide is an invitation to experiment, not a disclosure of RNA sequences. This is not sufficient to support a rejection for anticipation. Thus, Applicants submit that the rejection should be withdrawn.

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For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully submitted,

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